

REMARKS

The Applicant has carefully considered this application in connection with the Examiner's Action and respectfully request reconsideration of this application in view of the foregoing amendments and the following remarks.

In the present response, the Applicant has amended Claim 1 and canceled Claims 5-7. These amendments should not necessitate a new search because the subject matter added to independent Claim 1 previously appeared in dependent Claims 5-6 submitted with the original application. Accordingly, Claims 1-3 and 8-11 are currently pending in the application.

I. Rejection of Claims 1-3 and 8-11 under 35 U.S.C. §103

The Examiner rejected Claims 1-3, 5 and 8-11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,551,935 to Sinha, *et al.* ("Sinha") in view of U.S. Patent 3,874,129 to Deckert *et al.* ("Deckert"). Former Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Sinha in view of Deckert and further in view of U.S. Patent 4,968,381 to Prigge, *et al.* ("Prigge"). Former Claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over Sinha in view of Deckert, and further in view of U.S. Patent 5,906,949 to Sato ("Sato").

The Applicant maintains that the combination of Sinha in view of Deckert do not teach or suggest all the elements recited in Claim 1 and its dependent claims. As acknowledged by the Examiner Sinha in view Deckert fail to teach that "a ratio of said silicic acid to said silicic salt is between about 100:1 and 1:100," as now recited in Claim 1 (Section 3 of Examiner's Detailed Action of 11/16/2006).

The Applicant maintains that Sinha in view of Deckert, and further in view of Prigge, also does not teach or suggest the ratio of silicic acid to silicic salt recited in Claim 1.

In rejecting Claim 6 the Examiner cited Prigge (Column 2, lines 5-11) for the proposition of teaching this element of the claim. The Examiner argued that since Prigge illustrates a polishing slurry of silica and silicate salt is known it would be obvious to modify Sinha in view of Deckert by selecting any proportion of of silicic acid or silicates in the Prigge reference. The Examiner indicates that this follows:

because the combination has been shown to effectively accomplish the disclosed composition in a method of polishing a composition (see Prigge, column 2, lines 11-14). (Section 3 of Examiner's Detailed Action of 11/16/2006)

In response, the Applicant respectfully submits that the recited section of Prigge does not teach or suggest a ratio of silicic acid to silicic salt of between about 100:1 and 1:100. The section of Prigge recited by the Examiner states:

The polishing solution used in the initial phase contains as an additional component, 1 to 20% by volume of a polishing sol or gel, beneficially based on silicic acid, or a solid polishing component, such as, for example, quartz flour, or silicates or fluoro silicates, for example, of sodium, potassium, magnesium, calcium or barium. Such additives are generally standard and are known to the person skilled in the art, for example, from the patent literature mentioned above; they do not therefore require a more detailed explanation here. (emphasis added, Prigge, Column 2, lines 5-14)

The Applicant submits that the above cited section make no mention of the ratio of silicic acid to silicic salt taught in the present application, and does not even teach or suggest the combined use of silicic acid and silicic salt. Rather, the above-cited section of Prigge merely discloses that 1 to 20 vol% of his polishing solution can have a polishing sol or gel that is based on silicic acid, or as an alternative, a solid polishing component, with silicate being an example of the solid polishing component. The Applicant's contention that Prigge teaches or suggests that silicic acid and the solid polishing component are used as alternative polishing sol or gel components is further

supported by Prigge's Examples 1-4. Examples 1-4 all use a silicic acid sol with no mention of the presence of a solid polishing component, such as silicate (Prigge, Columns 5-6).

The Applicant therefore respectfully maintains that the claimed invention is not obvious in view of the foregoing combined references, and that various combinations of these reference fail to establish a *prima facie* case of obviousness of Claims 1-3 and 8-11. The Applicant therefore respectfully requests the Examiner to withdraw the rejection and allow Claims 1-3 and 8-11 to issue.

II. Conclusion

In view of the foregoing amendment and remarks, the Applicant sees all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicit a timely Notice of Allowance for Claims 1-3 and 8-11.

It is not believed that any fees are due regarding this matter. However, the Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 08-2395.

The Applicant requests the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application.

Respectfully submitted,
Hitt Gaines, P.C.


Ronald J. Corbett
Registration No. 47,500

Dated: January 8, 2007

Hitt Gaines, P.C.
P.O. Box 832570
Richardson, Texas 75083-2570